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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,564	10/23/2000	Steve W. Irons	IMAG-0123	1951
23123	7590	02/08/2005	EXAMINER	
SCHMEISER OLSEN & WATTS			LETT, THOMAS J	
18 E UNIVERSITY DRIVE				
SUITE # 101			ART UNIT	PAPER NUMBER
MESA, AZ 85201			2626	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,564

Applicant(s)

IRONS ET AL.

Examiner

Thomas J. Lett

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see p12, paragraphs 1 and 2 filed 20 September 2004, with respect to claims 1, and 4-9 have been fully considered and are persuasive. The rejections of claims 1, and 4-9 have been withdrawn.
2. Applicant's arguments, see p13, paragraphs 4-5, filed 20 September 2004, with respect to the rejections of claim(s) 22-27 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cooper et al (USPN 5,465,167) disclosing a method of creating cover sheets that extracts identifiers or mnemonics that can represent documents to be faxed with cover sheets.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- KAW*
22-27 are
3. Claims ~~22~~ ²²⁻²⁷ are rejected under 35 U.S.C. 102(b) as being anticipated by Cooper et al (USPN 5,465,167).

With respect to claim 22, Cooper et al disclose a system (see Fig. 3) for creating a dynamically-generated fax cover sheet (automatically creates a cover sheet that includes an image of the identifier field from the form, col. 7, lines 18-20) comprising:

a dynamically-generated fax cover sheet (FIG. 9 shows an automatically created cover sheet 650), said dynamically-generated fax cover sheet comprising at least one dynamic content zone (e.g., fields 652, 654), wherein said at least one dynamic content zone(s) contains a globally unique identifier which was generated by a digital filing application (Form action automatically creates a cover sheet and can transmit the document "Big Deal"(identifier), col. 17, lines 21-26); and

a digital image of said dynamically-generated fax cover sheet, said globally unique identifier linking said dynamically-generated fax cover sheet to a record in a database (information database 322, which stores a pointer that indicates a DOS file that contains a document, col. 9, lines 5-7) said record having been created prior to the creation of said digital image of said dynamically-generated fax cover.

With respect to claim 23, Cooper et al disclose the dynamically-generated fax cover sheet of claim 22 further comprising at least one static content zone (Fig. 9, see the zone "To:").

With respect to claim 24, Cooper et al disclose the dynamically-generated fax cover sheet of claim 22 wherein at least one of the at least one dynamic content zone contains a piece of system-generated (by Form, Send, or Retrieve action, col. 17, lines 37-38) data which is document-specific information (In addition to the information shown on cover sheet 650, an automatically created cover sheet could include the title of a

transmitted document, the total page count, the date and time, and so forth, col. 17, lines 40-44).

With respect to claim 25, Cooper et al disclose the dynamically-generated fax cover sheet of claim 22 wherein at least one of the at least one dynamic content zone contains a piece of system-generated (by Form, Send, or Retrieve action, col. 17, lines 37-38) data which is user-specific information (In addition to the information shown on cover sheet 650, an automatically created cover sheet could include the telephone number of the recipient and the name of the sender, col. 17, lines 40-44).

With respect to claim 26, Cooper et al disclose dynamically-generated fax cover sheet of claim 22 wherein at least one of the at least one dynamic content zone contains a piece of user-generated data (a user may enter information in field 600 to indicate document-specific information to translate to cover sheet 650, see Figs. 8 and 9) which is document-specific information.

With respect to claim 27, Cooper et al disclose dynamically-generated fax cover sheet of claim 22 wherein at least one of the at least one dynamic content zone contains a piece of user-generated data (a cover sheet could include the name of the sender, col. 17, lines 40-44).

Allowable Subject Matter

4. Claims 1-21 are allowed.
5. The following is an examiner's statement of reasons for allowance: although Cooper et al (USPN 5,465,167) disclose methods of generating cover pages, the

Art Unit: 2626

Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of said prior art which teaches “at least one digital image of a paper-based document the digital image comprising at least one image of a dynamically-generated fax cover sheet, the at least one digital image residing in the memory; and a digital filing application residing in the memory and being executed by the at least one processor, the digital filing application extracting a globally unique identifier from the image of the dynamically generated fax cover sheet and using the globally unique identifier to link the digital image to a database record which was created prior to the creation of the digital image” as recited in claim 1.

In addition, the Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of said prior art which teaches “indexing a paper-based document using a digital filing application, thereby creating a record in a database describing the paper-based document; processing the dynamically-generated fax cover sheet and the paper-based document to create a digital image of the paper-based document and the dynamically-generated fax cover sheet wherein the dynamically-generated fax cover sheet acts as a fax cover sheet for the paper-based document; extracting the globally unique identifier from the digital image; storing the digital image in a file, using the globally unique identifier to name the digital image and to link the digital image to the record in the database” as recited in claim 17.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

Art Unit: 2626

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II

2121 Crystal Drive

Arlington, VA

Sixth Floor (Receptionist).

TJL

(TJL)


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER